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REMARKS

Claims 29, 31, 48-52 and 55-59 are presently pending in the application.

The Office Action rejected claims 29, 31, 48-52 and 55-59 under 35 U.S.C. 103(a) as being unpatentable over WO '928 (WO 97/07938) in view of Vassiliadis et al. (U.S. Patent No. 5,324,200). Applicants respectfully traverse this rejection.

Of these rejected claims, Claims 29 and 31 are independent.

Independent claim 29 is directed to a combination of claim limitations including, among other things, "...directing electromagnetic energy ... [while] simultaneously placing moisture comprising an anesthetic and a vassal constrictor ... [and then] directing electromagnetic energy ... without any simultaneous placement of moisture" (emphasis added), which is neither disclosed nor suggested by WO '928 and Vassiliadis et al., taken separately or together.

Regarding independent claim 31, it is directed to a combination of claim limitations including, among other things, "directing electromagnetic energy ... [and] placing first amounts of moisture comprising an anesthetic and a vassal constrictor ... during the first time period ... [and then] directing electromagnetic energy ... and placing second amounts of moisture ... less than the first amounts of moisture and containing no or lower concentrations of anesthetic and vassal constrictor than the first amounts" (emphasis added), which is neither disclosed nor suggested by WO '928 and Vassiliadis et al., taken separately or together.

Thus, each of the independent claims contains a limitation of a second placement with less moisture than the first. However, neither of the prior-art references appear to contain any suggestion of such a process wherein a second placement is made with less

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moisture than the first. Since Vassiliadis et al. teaches using more moisture with increased power, his second rapid-cutting placement would appear to contain more moisture. As for the WO '928 reference, while mentioning that fluid conditioning can be implemented with thermal lasers, the reference does not appear to suggest a second placement with less moisture than the first. Thus, Applicants do not find any such teaching of this limitation in any of the references, so that, accordingly, any combination of the references still would not contain such a limitation.

In any event, Applicants do not even consider the two references to be combinable. Applicants have previously discussed how these two references would not appear to be combinable, and incorporate that discussion herein. However, even if they were to be combined, Applicants submit that the result would not contain a second placement with less moisture than the first. Incorporating the desensitization technique of Vassiliadis et al. before a fluid cutting technique of WO '928 would appear to yield a second placement with more moisture than the first, and incorporating the rapid-cutting technique of Vassiliadis et al. after a fluid cutting "desensitization" (low power) technique of WO '928 would also appear to yield a second placement with more moisture than the first since Vassiliadis et al. discloses applying fluid, e.g., more fluid, for higher-power cutting (cf. col. 6, lines 5-14 and col. 7, lines 41-51).

As for the combination of a Vassiliadis et al. rapid-cutting process, as an initial step, followed by a WO '928 fluid-cutting "clean up" process, neither technique is disclosed or suggested in either of the references. The rapid-cutting technique of Vassiliadis et al. is a second-step process (to be implemented after desensitization), not a first step, and WO '928 does not disclose a clean-up technique as a first or a second step. Moreover, there is no teaching in the prior art that such a combination of steps would even work, and there certainly is no suggestion in the prior art of record that such a combination (of techniques which are nowhere disclosed, in an order nowhere contemplated) would save time or be less stressful on the patient. To the extent Vassiliadis et al. discloses a desensitization step

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followed by a rapid-cutting step as saving time and being less stressful, that does not suggest that adding a subsequent (aka, third-step) clean-up process would be faster or less stressful. Clearly, this added step would appear to take more time, not less, and, if anything, may operate to impose more stress on the patient, not less.

Furthermore, even if the clean-up step were hypothetically combinable with the Vessiliadis et al. steps, neither reference discloses any of the presently claimed combinations of steps including, among other things, the use of an anesthetic or vassal constrictor during the second (or final) application of electromagnetic energy to a treatment area, and there is no motivation to incorporate such a step during the final pass of the complex combination of steps proffered by the Office Action. The mere disclosure of conditioning fluid particles with anesthetics of WO '928 does not suggest the contemplated combination of the Office Action. In fact, even if the combination were possible, the final pass with an anesthetic still would not meet the language of, for example, claim 31 that that pass contain "no or lower concentrations of anesthetic or vassal constrictor than the first amounts."

The Office Action's suggestion of "employing the non thermal cutting steps of ... WO '928 in the method of Vassiliadis et al." is not clear. To the extent the Office Action is referring to a desensitization WO '928 application followed by a rapid-cutting process of WO '928, it is noted that any such combination would not appear to meet the claim 29 language of, among other things, "...directing electromagnetic energy ... [while] simultaneously placing moisture comprising an anesthetic and a vasal constrictor ... [and then] directing electromagnetic energy ... without any simultaneous placement of moisture" since, if anything, the second step would by Applicants' interpretations appear to contain more moisture. Moreover, any such combination would not appear to meet the claim 31 language of, among other things, "directing electromagnetic energy ... [and] placing second amounts of moisture comprising an anesthetic and a vassal constrictor ... during the first time period ... [and then] directing electromagnetic energy ... and placing

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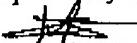
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second amounts of moisture ... less than the first amounts of moisture and containing no or lower concentrations of anesthetic and vassal constrictor than the first amounts" since, if anything, the second step would by Applicants' interpretations appear to contain more moisture.

In view of the above, Applicants request that the outstanding rejections be reconsidered and withdrawn. Applicants respectfully submit that the application is now in condition for allowance, and an early indication of same is requested. The Examiner is invited to contact the undersigned with any questions.

Respectfully submitted,

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